



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

C

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/502,309 | 07/22/2004 | Eric Vettillard | 190-77 | 9172 |
| 2746 | 7590 | 10/19/2006 | EXAMINER | |
| WILLIAM H. EILBERG THREE BALA PLAZA SUITE 501 WEST BALA CYNWYD, PA 19004 | | | DOAN, TRANG T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2131 | |

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/502,309 | VETILLARD, ERIC | |
| | Examiner | Art Unit | |
| | Trang Doan | 2131 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 July 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-9 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 22 July 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Taghji J. Avani
Primary Examiner
Art 213
Taghji J. Avani
10/14/06

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 07/2004.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

1. Claims 1-9 are pending.
2. The application is filed on 07/22/2004 but claims the benefit of Foreign Priority has been made and acknowledged. Therefore, the effective filing date for the subject matter defined in the pending claims in this application is 02/01/2002.

Claim Objections

3. Claims 1-9 are objected because the preambles cite "method" and "device" are incorrect. The examiner interprets as "a method" and "a device". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 recites the limitation "transmitted messages" in line 9. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 4 recites the limitation "transmitted messages" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 2131

8. The following words or phrases are not clearly understood rendering the corresponding claims vague or indefinite:

- a) "inserted permanently into the network", in claims 1 and 4, line 6. It is not clear whether the authority or the device inserts between the server and the client.
- b) "translate the transmitted messages", in claims 1 and 4, lines 8-9. It is not clear what the "translating" process means within the scope of the claim.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 4 are directed to a method or device for performing a data exchanged between a client and a server over a data transmission network. The claims are not limited to tangible embodiment. As such, the claims are not limited to statutory subject matter and is therefore non-statutory.

Claim 1 is directed to a method claim, however the claim recites no acts or steps involved in the method claim, results in an improper definition of a method, i.e., results in a claim which is not a proper method claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Urien (US 2002/0138549) (hereinafter Urien).

12. Regarding claim 1, Urien teaches a method of securing messages exchanged over a data transmission network between a server (1) and a small client (2) that does not have the resources necessary for providing security functions, under the control of an authority that defines message exchange rules, wherein control is provided in a decentralized manner by a representative (3) of the authority , inserted permanently into the network in the vicinity of the client (2) and between the server (1) and the client (2) during the secure exchange of messages (Urien: see figure 6 and paragraphs [0043, 0157, 0153, 0216-0218]; a smart card cited in Urien inserts between a client and a server, which controls data exchanged between the client and the server), to translate transmitted messages and to apply verifications decided on by the authority to transmitted messages (Urien: see figure 6 item 28 and paragraphs [0043-0044, 0046, 0054, 0193, 0216]; a filter of the smart card performs encryption/decryption operation to the data exchanged between the client and the server).

Art Unit: 2131

13. Regarding claim 2, Urien teaches wherein a first protocol (P) is used for exchanges between the server (1) and the representative (3) of the authority, and a second protocol (P') different from the first protocol (P) is used for exchanges between the representative (3) of the authority and the client (2) (Urien: see figure 6 and paragraphs [0049-0051, 0077, 0083]).

14. Regarding claim 3, Urien teaches wherein, for the exchange of messages: a first secure channel (4) is set up between the server (1) and the representative (3) of the authority, using a first key (Ks) known to the representative (3) of the authority and to the server (1) but not to the client (2), and using a first encryption algorithm (AL), and a second secure channel (5) is set up between the representative (3) of the authority and the client (2), using a second key (Kc) known to the representative (3) of the authority and to the client (2) but not to the server (1), and using a second encryption algorithm (AL') (Urien: see figure 6 and paragraphs [0157, 0193, 0219, 0244-0245, 0247, 0252-0253]).

15. Regarding claim 4, this claim has limitations that is similar to those of claim 1, thus it is rejected with the same rationale applied against claim 1 above.

16. Regarding claim 5, Urien teaches wherein the decentralized control device or representative (3) of the authority is a data processing microsystem secured by hardware, inserted permanently between the server (1) and the client (2) during the exchange of messages (Urien: see figure 6 and paragraph [0247]).

17. Regarding claim 6, Urien teaches wherein: the server (1) is a data processing system comprising an input-output port (1a) (Urien: see figure 6 and Abstract section);

the client (2) is a data processing microsystem comprising an input-output port (12) (Urien: see figure 6); the representative (3) of the authority is a data processing microsystem secured by hardware and comprising an interface device (13) (Urien: see figure 6 and Abstract section); a dedicated interface system (7) is provided, comprising an input-output port (8) connected to the input-output port (1a) of the server data processing system (1), comprising a card port (9) connected to the input-output port (12) of the client data processing microsystem (2), comprising an input-output port (10) connected to the interface device (13) of the representative (3) of the authority data processing microsystem, and comprising a controller (11) programmed to control communication between the input-output ports (8), (9) and (10) (Urien: see figure 6); the controller (11) and the representative (3) of the authority are programmed so that: the server data processing system (1) sends a request A to the client data processing microsystem (2), and that request is received by the controller (11) (Urien: see figure 6 and paragraph [0247 and 0253]); the controller (11) transmits the request A to the representative (3) of the authority, which sends it back a response Ra (Urien: see figure 6 and paragraphs [0054, 0157, 0216, 0247 and 0253]); the controller (11) uses that response Ra to calculate a request A' that is sent to the client data processing microsystem (2) (Urien: see figure 6 and paragraphs [0054, 0157, 0216, 0247 and 0253]); the client data processing microsystem (2) processes the request A' to prepare a response B' (Urien: see figure 6 and paragraphs [0054, 0157, 0216, 0247 and 0253]); the client data processing microsystem (2) sends the response B' to the server data processing system (1) (Urien: see figure 6 and paragraphs [0054, 0157, 0216, 0247,

Art Unit: 2131

0253]); that response is received by the controller (11); the controller (11) transmits the response B' to the representative (3) of the authority, which sends it back a response Rb (Urien: see figure 6 and paragraphs [0054, 0157, 0216, 0247 and 0253]); the controller (11) uses that response Rb to calculate a response B that is sent to the server data processing system (1) (Urien: see figure 6 and paragraphs [0054, 0157, 0216, 0247 and 0253]).

18. Regarding claim 7, Urien teaches the client (2) is a smart card; the representative (3) of the authority is a smart card; the dedicated interface system is a smart card reader (7) comprising two card ports (9) and (10) (Urien: see figure 6 and Abstract section).

19. Regarding claim 8, Urien teaches wherein: the client (2) is a mobile communication system; the server (1) is a data processing system communicating with the client (2) via a physical connection or via a wireless communication network; the representative (3) of the authority is a smart card representing the operator of the wireless communication network (known as the SIM card in telephones conforming to the GSM standard) (Urien: see figure 6 and Abstract section and paragraphs [0004 and 0087]).

20. Regarding claim 9, Urien teaches the client (2) is a smart card; the representative (3) of the authority is a data processing system secured by hardware; the dedicated interface system (7) is a machine comprising a card port (9) and a dedicated input-output interface (10) for connection to the representative (3) of the authority data processing system (Urien: see figure 6 and Abstract section).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trang Doan whose telephone number is (571) 272-0740. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Trang Doan
Examiner
Art Unit 2131

T.D.
10/13/2006

Trang J. Doan
Primary Examiner
Art Unit 2131
Trang J. Doan
10/14/06